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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR   | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|------------------------|---------------------|------------------|
| 10/687,575   | 10/15/2003  | Michael J. Hafer       | 026595-007610       | 7753             |
| 20350 7590 01/07/2010<br>TOWNSEND AND TOWNSEND AND CREW, LLP<br>TWO EMBARCADERO CENTER<br>EIGHTH FLOOR<br>SAN FRANCISCO, CA 94111-3834 |             |                        |                     |                  |
| EXAMINER<br>HAMILTON, LALITA M   |             |                        |                     |                  |
| ART UNIT<br>3691   |             | PAPER NUMBER           |                     |                  |
| MAIL DATE<br>01/07/2010  |             | DELIVERY MODE<br>PAPER |                     |                  |

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/687,575  
Filing Date: October 15, 2003  
Appellant(s): HA FER ET AL.

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Irvin E. Branch  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed October 12, 2009 appealing from the Office action mailed June 9, 2009.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

|                 |            |         |
|-----------------|------------|---------|
| 6,690,779       | WALKER     | 2-2004  |
| 7,287,009       | LIEBERMANN | 10-2007 |
| US 2002/0099607 | SOSA       | 7-2002  |

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 23-29 are rejected for being directed to a card. The Applicant argues that the convenience card has embedded instructions; however, the instructions embedded within the card are not carried out utilizing a computer. Therefore, the rejection will be maintained.

Claims 30-47 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively

recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, Applicant's method steps are not tied to a particular machine and do not perform a transformation. Thus, the claims are non-statutory.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101. *Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al.*

The Applicant argues that the method carries out an electronic transformation of data. However, the method is not executed by a computer. Therefore, there is not transformation of data, as claimed by the Applicant. The rejection will be maintained.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-20 and 22-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sosa (2002/0099607) in view of Walker (6,690,779) and Liebermann (7,287,009).

Sosa discloses a system and corresponding method for providing incentive for money transfer services substantially as claimed (p.3, 36-37; p.8, 57-58; and p.19, 126 to p.20, 128). Sosa further discloses an automatic population option that fills in saved information (para.62) and visually displaying transaction information (para.70). However, Sosa does not disclose an award being redeemable by the customer for credit toward the purchase of a product from a service provider or calculating an amount of prepaid telephone service credit or return to the point of sale device stored transaction information identifying prior money transfer recipients of the customer for use by the point of sale device. Walker teaches a method and corresponding system for awarding and redeeming prepaid telephone time comprising award being redeemable by the customer for credit toward the purchase of a product from a service provider or calculating an amount of prepaid telephone service credit (col.2, lines 43-60 and col.8, line 50 to col.9, line 24). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Walker within Sosa for the motivation of allowing the user to an alternative prize in the form of credits towards prepaid telephone service. Liebermann teaches a method and corresponding system for carrying out business transactions comprising identifying historical transaction information pertaining to money transfer recipients of the customer (col.11, line 55 to col.12, line 20 and col.15, line 59 to col.17, line 35). It would have

been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Walker and Leibermann within Sosa for the motivation of allowing for more convenience in transferring funds and tracking customers.

#### **(10) Response to Argument**

The Appellant argues that claims 23-29 and 30-47 were improperly rejected under 35 U.S.C. 101. With regard to claim 23, the Appellant argues that the Examiner has misconstrued the language of the claim and that "the claim clearly refers to a physical item (money transfer convenience card) with a list (data structure) stored thereon." In response, as stated in the final office action, the claim is directed towards a card whose embedded information is not executed by a computer. The physical nature of the card is not enough. The card must be used in conjunction with a computer to be considered statutory. Therefore, the Examiner maintains the rejection.

With regard to claims 30-47, the Appellant argues that the Examiner failed to consider the arguments previously set forth. In response, the Examiner stated the following on p.2-3 of the final rejection mailed on June 9, 2009:

Claims 30-47 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the

particular machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, Applicant's method steps are not tied to a particular machine and do not perform a transformation. Thus, the claims are non-statutory. The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101. *Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al.*

The Applicant argues that the method carries out an electronic transformation of data. However, the method is not executed by a computer. Therefore, there is not transformation of data, as claimed by the Applicant. The rejection will be maintained.

Therefore, the Examiner maintains the rejection with regard to claims 30-47.

The Appellant argues that the combination of the Sosa, Walker, and Liebermann references do not disclose "return to the point-of-sale device stored transaction information identifying prior money transfer recipients of the customer for use by the point-of-sale device to automatically prepare a transaction form associated with the request to process the money transfer transaction ...." In response, Sosa discloses that the "USER2 519 may cut and paste the valid charge information 617 from the cash account system 107 into the merchant purchase page or may select an automatic population option offered by the cash account system 107 that automatically fills the valid charge information 617 into the purchase page upon indication by USER2 519. (para.62)." The automatic population featured may be used to populate forms with saved information. Liebermann teaches identifying historical information pertaining to money transfer recipients. More specifically, Liebermann teaches the following:



One of the advantages to the FCT system is that no transaction in the FCT system occurs without a TIW being open and no transaction is completed successfully without properly closing the TIW. **The TIW contains all the historic information related to the transaction**, as well as the needed handshakes for it to be completed successfully

col.11, line 55 to col.12, line 21.

The Examiner is interpreting the automatic population feature of Sosa as being capable of automatically populating any type of information into the form, including historical information of money transfer recipients. Further, automatically populating documents is not a novel feature. Therefore, the Examiner is interpreting the combination of references as reading onto the invention as claimed.

Regarding the Appellant's argument pertaining to the recitation, the corrected recitation was set forth on p.3 of the Office Action mailed on August 7, 2008 prior to the action mailed on December 8, 2008, which was cited by the Appellant.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Art Unit: 3691

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Lalita M Hamilton/

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Vincent Millin /vm/

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